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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte
GARY D. BARNETT, SCOTT C. BROWN,
and MARK B. LESTER

Appeal 2008-1560
Application 10/675,064
Technology Center 3700

Decided: March 28, 2008

Before TONI R. SCHEINER, ERIC GRIMES, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims directed to an adjustable length modular long bone prosthesis, configurable between a right mode and a left mode. The Examiner has rejected the claims as indefinite, anticipated, and obvious. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

Claims 12, 13, 17, and 21-34 are pending in the application. Of these claims, claims 12, 13, and 17 have been indicated allowable (Final Rejection 2). In addition, claims 22 and 28-31 are still pending, but Appellants indicate they “are not being appealed” (App. Br. 5). Finally, the Examiner has withdrawn the rejection of claims 21 and 25-34 as anticipated by Hickey (U.S. Patent 5,645,607, issued July 8, 1997) (Ans. 3), and the rejection of claim 26 as unpatentable over Gray (U.S. Patent 6,149,687, issued November 21, 2000) (Ans. 5, 8).

Accordingly, the appeal is DISMISSED with respect to claims 22 and 28-31, and the only rejections remaining before us on appeal are as follows:

- The rejection of claims 21 and 23-27 under 35 U.S.C. § 112, second paragraph, as indefinite.
- The rejection of claim 32 under 35 U.S.C. § 102(b), as anticipated by Gray.
- The rejection of claim 21 under 35 U.S.C. § 103(a), as unpatentable over Gray.

Claims 21 and 32 are representative and reproduced below; claim 28, from which claim 32 depends, is reproduced as well:

21. A modular long bone prosthesis, comprising:
a proximal component having a first coupler at a proximal end thereof and a second coupler at a distal end thereof;
a retroversion component having [a] third coupler at a proximal end thereof and a fourth coupler at a distal end thereof, said third coupler being configured to mate with said second coupler of said proximal component so as to retain said retroversion component in fixed relation to said proximal component;

a head component having a fifth coupler configured to mate with the first coupler of said proximal component so as to retain said head component in fixed relation to said proximal component,

wherein said one of said proximal component and said retroversion component has a tab, and

wherein the other one of said proximal component and said retroversion component has a first slot and a second slot,

wherein said proximal component and said retroversion component are configurable between a right long bone mode and a left long bone mode,

wherein when in said right long bone mode (i) said second coupler of said proximal component is positioned in mating relationship with said third coupler of said retroversion component, (ii) said tab is positioned in said first slot, and (iii) no tab is positioned in said second slot, and

wherein when in said left long bone mode (i) said second coupler of said proximal component is positioned in mating relationship with said third coupler of said retroversion component, (ii) said tab is positioned in said second slot, and (iii) no tab is positioned in said first slot.

28. A modular long bone prosthesis, comprising:

a proximal component having a first coupler;

a retroversion component having a second coupler being configured to mate with said first coupler of said proximal component so as to retain said retroversion component in fixed relation to said proximal component;

wherein said one of said proximal component and said retroversion component has a tab, and

wherein the other one of said proximal component and said retroversion component has a first slot and a second slot,

wherein said proximal component and said retroversion component are configurable between a right long bone mode and a left long bone mode,

wherein when in said right long bone mode (i) said first coupler of said proximal component is positioned in mating relationship with said second coupler of said retroversion component, (ii) said tab is positioned in said first slot, and (iii) no tab is positioned in said second slot, and

wherein when in said left long bone mode (i) said first coupler of said proximal component is positioned in mating relationship with said second coupler of said retroversion component, (ii) said tab is positioned in said second slot, and (iii) no tab is positioned in said first slot.

32. The modular long bone prosthesis of claim 28, wherein said first slot and said second slot are positioned adjacent to each other.

DISCUSSION

Definiteness

Independent claim 21, and its dependent claims 23-27 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

The Examiner contends that “applicant is purposely confusing the couplers terminology” as “[t]he coupler names [in claim 21] are not consistent” with the coupler names in claim 28 (Ans. 3).

We will reverse this rejection. Claim 21 is an independent claim, and stands on its own. The Examiner does not contend that the coupler terminology in claim 21 is internally inconsistent, and has not explained why claim 21, standing on its own, is indefinite.

We therefore reverse the § 112, second paragraph, rejection of claims 21 and 23-27.

Anticipation

Claim 32 stands rejected under 35 U.S.C. § 102(b) as anticipated by Gray.

Claim 32 is directed to the modular long bone prosthesis of claim 28, where the first and second slots are on either the proximal component or the retroversion component of the prosthesis, and the first and second slots are adjacent to each other.

The Examiner finds, in the pertinent part, that Gray describes a long bone prosthesis “wherein said one of said proximal component and said retroversion component has a first slot **48** and a second slot **46**” (Ans. 4).

Appellants contend that Gray's "slots **46** and **48** are not 'positioned adjacent to each other' as called for in claim 32. Rather, Gray's first slot **46** is offset from its second slot **48** by 180° along the outside periphery of [the] component in which the slots **46**, **48** are defined. Positioning two slots 180° apart from each other is the antithesis of being adjacent to each other. Moreover, a threaded recess configured to receive a threaded member is interposed between the slots **46** and **48**" (App. Br. 19).

The Examiner does not dispute that Gray's slots **46** and **48** are positioned 180° apart along the outside periphery of the prosthesis component, but contends that they "are correctly defined as being positioned adjacent to each other" (Ans. 7), because the word "adjacent" can be defined as "near or close to but not necessarily touching" (Ans. 7).

"It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation *consistent with the specification*." *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983) (emphasis added).

Gray's slots **46** and **48** may be near each other, in the sense that any two features on the same component are near each other, but they are positioned as far apart as they can possibly be on the outside periphery of the component. Moreover, we note that the present Specification describes several embodiments of the prosthesis, some of which have two slots **112** described as "diametrically opposed on the cylindrical body **100**" (Spec. 16), i.e., 180° apart. *See* Figure 1. This is in contrast to the arrangement of slots **70**, **72** also shown in Figure 1. While the present Specification does not explicitly define the term "adjacent," we find that it is not reasonable to

interpret Gray's slots **46** and **48** as "adjacent" to each other, as the present Specification uses the term "diametrically opposed" to describe two slots positioned 180° apart.

The rejection of claim 32 under 35 U.S.C. § 102(b) as anticipated by Gray is reversed.

Obviousness

Claim 21 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Gray.

According to the Examiner, Gray "is unclear regarding a head component and a coupling means (first and fifth couplers). It would have been obvious . . . to include a head component (insert or articulating component) and a coupling means such that the system could be fully sized and trialed" (Ans. 6).

Appellants argue that "the proximal tibial trial system **10** of Gray appears to be completely functional as disclosed and does not suggest or imply that any component, much less, a head component needs to be attached to it so that 'the system could be fully sized and trialed.'" (App. Br. 21).

The Examiner has not directly addressed Appellants' argument. Instead, the Examiner has cited a number of references (Ans. 7-8), which were not included in the rejection, "as official notice which teach trial systems similar to Gray . . . having a head component" (Ans. 8). Not only were these references not included in the rejection of claim 21, but the Examiner has made no attempt to explain how they relate to Gray, or why they would make it obvious to add a head component to Gray's prosthesis,

other than characterizing the references as describing “similar” trial systems (Ans. 8). Accordingly, we have not considered the references.

We find that the Examiner has not provided an adequate factual basis to establish that the invention of claim 21 would have been obvious over Gray’s teachings. The rejection of claim 21 under 35 U.S.C. § 103(a) is reversed.

SUMMARY

The rejection of claim 21 and 23-27 under 35 U.S.C. § 112, second paragraph, is reversed.

The rejection of claim 32 under 35 U.S.C. § 102(b) as anticipated by Gray is reversed.

The rejection of claim 21 under 35 U.S.C. § 103(a) as unpatentable over Gray is reversed.

The appeal is dismissed with respect to claims 22 and 28-31.

REVERSED

lp

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